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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/791,688 | 03/01/2004 | Jeffrey Bergh | 129843.1082 (H.072A) | 2600 |
| 60148 | 7590 | 09/04/2008 | | |
| GARDERE / RJW GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201 | | | EXAMINER KENNEDY, JOSHUA T | |
| | | | ART UNIT 3679 | PAPER NUMBER |
| | | | MAIL DATE 09/04/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/791,688 | Applicant(s) BERGH ET AL. | |
| | Examiner JOSHUA T. KENNEDY | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/23/2008 has been entered.

Claims 1-78 have been cancelled.

Claims 79-91 have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 79-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caceres et al in view of Gleeson et al and Newberry.

As to Claim 79, Caceres et al disclose a fencing system comprising:

a horizontal mounting surface (15); and

an elongated member (13) having at least a front surface and a back surface (20), each of the front surface and the back surface having a pattern (Col 3, Lines 32-33), wherein the elongated member is constructed as an independent fencing component, not containing any attachments on the front surface or the back surface for attaching the elongated member to the horizontal mounting surface (Fig 1), wherein the elongated member is secured to the horizontal mounting surface only by a fastener passing through the front surface and back surface of the elongated member and into the horizontal mounting surface (Col 2, Lines 19-22).

However, Caceres et al do not disclose the elongate members comprising fiber cement having fibers, wherein the fiber cement forming the elongated member incorporates a low-density additive such as micro spheres or volcanic ash as well as moisture resistant cellulose fibers

Gleeson et al teach a fiber cement building material having cellulose fibers having low density additives of volcanic ash, microspheres or a combination thereof added to moisture resistant cellulose fibers that has “applicability to a number of building product applications, including but not limited to building panels, tie backer board... fencing, and decking” (Par. 107, Lines 1-5). Examiner notes that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the plurality of individual members of Caceres to be constructed of the fiber cement building material as taught by Gleeson et

al because of its applicability to a number of building product applications, including fencing and it's a lightweight material with "workability at an economical price, as well as improved dimensional stability" (Par. 10) such as a lowered density of the material, yielding expected and predictable results.

Further, Caceras et al do not disclose the pattern being formed of the same material as the elongated member. Examiner notes that the specific method of forming is not germane to the issue of patentability of the device itself. Therefore, the limitation "the pattern being formed of the same material as the elongated member" has been given only limited patentable weight and does not serve to structurally distinguish the claims. See MPEP § 2113. Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. *In re Klug*, 333 F.2d 905, 142 USPQ 161 (CCPA 1964). In an ex parte case, product by process claims are not construed as being limited to the product formed by the specific process recited. *In re Hirao et al.*, 535 F.2d 67, 190 USPQ 15, see footnote 3 (CCPA 1976).

Newberry Jr. teaches a similar fencing system having each component formed using the same material in a mold impression of a fence component. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fencing system of Caceras et al to have the exterior pattern being formed of the same material as the elongated member as taught by Newberry Jr. to more easily reproduce the surface of the panel desired (Col 4, Lines 37-44) without the requirement

of an additional process step or additional materials, yielding expected and predictable results.

As to Claim 80, it is noted that the limitation of “wherein the elongated member is cut to size and shaped for use in the fence system prior to curing the fiber cement, wherein the elongated member does not exhibit any substantial fraying of the fibers along the surfaces of the elongated member after curing” imparts limited patentable weight to the invention and that it is the patentability of the product, and not recited process steps, that is to be determined in product-by-process claims irrespective of whether or not only process has been recited. Accordingly, it is of little consequence how the surfaces features formed or how the members are sized and shaped when all features and structure are present. See MPEP § 2113. The claimed structure matter appears to be met by the rejection, above, and therefore it has been held that if the product defined in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process. See *In re Thorpe*, 77 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

As to Claim 81, Caceres et al disclose a fencing system wherein the elongated member has at least one surface that has a pre-finish thereon (Col 3, Lines 32-33).

As to Claim 82, Caceres et al disclose a fencing system wherein the elongated member resembles a picket (Fig 1)

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As to Claim 83, Caceres et al disclose a fencing system wherein the elongated member has an upper end, wherein the upper end is formed into a shape selected from the group consisting of square cut, dog-eared, French gothic, scalloped, pointed and saw-toothed (Fig 1).

As to Claim 84, Caceres et al disclose a fencing system wherein the front surface and back surface of the elongated member has a finish that resembles wood (Col 3, Lines 34-35).

As to Claim 85, Caceres et al disclose the fencing system significantly as claimed, but do not explicitly disclose the front surface and back surface of the elongated member has a finish that resembles masonry.

Newberry Jr. teaches a similar fencing system having “the general appearance of stone...fences” (Col 1, Lines 46-47). Newberry Jr. does not disclose any structural or functional significance as to the aesthetic appearance of the fence and Examiner notes that a change in ornamental design having no mechanical function is an aesthetic design consideration within the skill of the art. In re Seid, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Accordingly .it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fencing system of Caceres et al to have the appearance of masonry, as taught by Newberry, Jr. as the reference does not disclose any structural or functional significance as to the exterior

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appearance of the fence as this is merely an aesthetic design choice yielding expected and predictable results.

As to Claim 90, Caceres et al disclose a fencing system wherein the horizontal mounting surface has a longitudinal axis, and the elongated member is positioned in a manner such that a longitudinal axis of the elongated member is substantially perpendicular to the longitudinal axis of the horizontal mounting surface (Fig 1).

As to Claim 91, Caceres et al disclose a fencing system wherein the mounting surface comprises a rail (15).

Response to Arguments

Applicant's arguments with respect to claims 79-91 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA T. KENNEDY whose telephone number is (571)272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Joshua T. Kennedy/
Examiner, Art Unit 3679
8/25/2008

/Daniel P. Stodola/
Supervisory Patent Examiner, Art Unit 3679